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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,664	10/15/2001	Robert D. Herpst		3468

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ROGER M. RATHBUN  
13 MARGARITA COURT  
HILTON HEAD ISLAND, SC 29926

EXAMINER  
ALEXANDER, LYLE

ART UNIT PAPER NUMBER

1743

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/977,664

Applicant(s)

HERPST, ROBERT D.

Examiner

Lyle A Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,10-20,28,30-33,35-37 and 39-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,10-20,28,30-33,35-37 and 39-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 12, 18-20, 30-32, 35, 39, 46-48 and 50-51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Persky et al.

Persky et al. teach in columns 1-2 that it is known to use metal band saws to cut alkali-halide scintillator crystals. The taught saw has been read on the claimed sawing and the taught scintillator crystal has been read on the claimed "sample holder".

Claims 1-2, 12, 15-19, 28, 30-31, 35-37, 39-44 and 46-47 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Brown (USP 6,037,168).

Brown teaches a microbiological assembly (20) having a support (22) and a cover (30) attached in a hinged relationship. Columns 7-9 teach pressure sensitive adhesives or magnetic closure mechanism can be used to close the cover. The cover is taught as being made of a transparent glass material (see col. 12 lines 36+). Column 9 lines 46+ teach use of different materials including cellulose.

Claims 1-2, 15-19, 15, 28, 30-31, 35-37, 39-44 and 46-47 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chandler. (USP 5,869,345) or Bogart et al. (USP 5,468,606).

Chandler teaches a device (10) having a first opposable component (12) and a second opposable component (14) connected to each other by a hinge (30). There is a first window (40) and (38) are in the first and second components (12) and (14)

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respectively. Adhesive (16) is taught for securing the first and second components together.

Bogart et al. teach in figure 8 a device (20) having a hinge (30) that connects upper half (32) and lower half (34). There are apertures/windows that permit the automated analysis of the sample.

Claims 1-2, 15-19, 28,30-31,34-37,39-44 and 46-47 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jacobson et al. (USP4, 260,687).

Jacobson et al. teach a diagnostic device for measuring biological characteristics of microorganisms that includes bacterial colonies. A device (10) has a plurality of interconnecting chambers and a hinged cover (19) that folds over the device (10).

Claims 1-2,15-19,28,30-31,35-37,39-44 and 46-47 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shields et al. (USP 6,033,627).

Shields et al. teach a device (20) having a front panel (22) and bottom panel (24) joined by a hinge (26). Column 1 lines 10+ teach it is known to use adhesive, including pressure sensitive adhesives, to secure a cover panel shut Cellulose is taught as material of construction.

Claims 1-2,15-16, 18-19, 28, 30-31, 39-40 and 46-47 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ozbey et al. (USP 6,186,403).

Ozbey et al. teach a sample holder and method of using it in combination with a spectrometer. Figures 1-4 teach the holder as a rectangular card having a fold line equidistant from either end permitting the card to be folded in half to secure a sample therein. There is a window (116) through the card formed by the folding. Column 5

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teaches adhesive strips (108,120) and pressure sensitive adhesive (110) that surrounds the window (116) that has been read on the claimed adhesive. Figure 13 teaches a "plate window" (406) in combination with a recess (404) that has been read on the multiple windows. Additionally, figure 13 shows a sliding relationship between window (406) and the recess (404).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 10-20, 28, 30-33, 35-37 and 39-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear if the subject matter proposed in the 9/17/04 amendment to the specification is supported by the original specification.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 10-11,13-14,20, 32-33 and 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al., Shields et al., Chandler, Bogart et al. , Brown or Persky et al. .

Sée Jacobson et al. Shields et al. Chandler, Bogart et al., Persky et al. and Brown supra.

The art is silent to the claimed materials of construction of the glass, specifically the alkali halide such as potassium bromide/chloride and sodium chloride.

The court decided In re Leshin (125 USPQ 416) that selection of a material based upon its suitability of intended use would have been within the skill of the art in view of 35 USC 103.

Alkali halide crystal materials comprising potassium bromide/chloride or sodium chloride are well known in the art and advantageous because of their low cost, excellent optical properties and hardness.

It would have been within the skill of the art to modify Brown and use an alkali halide crystal materials comprising potassium bromide/chloride or sodium chloride to gain the above advantages and in view of Leshin because selection a material based upon its suitability of intended use.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozbey et al., Jacobson et al. Shields et al. Chandler, Bogart et al., Persyk et al. or Brown in view of Marker et al. (4,855,110)

Sée Ozbey et al., Jacobson et al. Shields et al. Chandler, Bogart et al., Persyk et al. and Brown supra.

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These references are silent to the use of a carousel for containing the slide to interface with an analyzer.

Marker et al. teach the use of a carousel in an automated analyzer. The carousel has the advantages of providing immediate access to all of the samples, which enables "stat" analysis of an important sample. Automated analyzers have the additional advantages of reducing human error, lower labor costs and permit 24/7 operations.

It would have been within the skill of the art to modify Ozbey et al., Jacobson et al. Shields et al. Chandler, Bogart et al., Persyk et al. or Brown in view of Marker et al. and use a carousel engaged with an automated analyzer to gain the above advantages.

### ***Response to Arguments***

Applicant's arguments filed 2/13/04 have been fully considered but they are not persuasive.

Applicants state all of the independent claims have been amended to better define the invention that the holding substrate is formed by one or more specific mechanical steps of cleaving, cutting, etc. MPEP 2113 states the patentability of a product does not depend upon its method of production. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 966. Once a product appearing to be substantially identical is found and a 35 USC 102/103 rejection made, the burden shifts to the Applicant to show an unobvious difference. Applicant's comments have not addressed the differences in the product made by the claimed mechanical steps.

Applicant states Persyk does teach a sawing technique for cutting scintillation material used for IR spectrophotometers but teaches a totally different method of

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producing the product. With respect to claims 1-17 the Office maintains states the patentability of a product does not depend upon its method of production as described above. The remainder of the claims are met by the prior art because an identical method of manufacture and using is contemplated.

Applicant states the balance of the references Jacobson et al., Shields et al., Chandler, Bogart et al., Brown are not related to the field of IR spectrometry and teach material incompatible with the instant invention. In the absence of better describing the physical characteristics of the claimed materials, the Office maintains they are indistinguishable from the cited prior art. Further, Applicant states these references will not meet the claimed limitation of "... without substantial absorption of infrared light ... ". Again, in the absence of describing the level of absorption of infrared light transmitted or absorbed, the Office maintains the instant claim language is broad enough to be read on the cited prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander  
Primary Examiner  
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